

REMARKS

Claims 1-67 remain for consideration. Claims 1, 5-6, 15, 33, 35, 37, 39-40, 46, 64, and 66 have been amended. All claims are thought to be allowable over the cited art.

The Office Action fails to set forth that Claims 5-6 and 39-40 are indefinite under 35 U.S.C. § 112, second paragraph. In the interest of advancing prosecution of the instant application, however, Applicant has amended Claims 5-6 and 39-40 in conformance with MPEP § 2173.05(h), which allows alternative expressions if they present no uncertainty or no ambiguity. Applicant respectfully requests, therefore, that the rejection to Claims 5-6 and 39-40 be withdrawn.

The Office Action fails to set forth a proper duplicate claims objection in relation to Claims 24-27; 29-32, and 55-58; 60-63 under MPEP § 706.03(k).

In particular, the Office Action fails to recognize: that Claims 24-27 depend from independent Claim 23; that Claims 29-32 depend from independent Claim 28; that Claims 55-58 depend from independent Claim 54; and that Claims 60-63 depend from Claim 59. Thus, each dependent claim set that the Office Action objects to depends from a different independent claim, where each independent claim sets forth alternate expressions of subject matter that the Applicant regards as his invention. MPEP § 706.03(k), however, recognizes the right of the Applicant to restate his invention in a reasonable number of ways, i.e., by plural claiming. Indeed, a mere difference in scope between claims has been held to be enough.

Claims 23 and 54, for example, set forth a method and apparatus that at least "identifies a target entity of the plurality of entities". Claims 28 and 59, on the other hand, set forth a method and apparatus that at least "identifies a transmitting entity and a target entity of the plurality of entities." Independent Claims 23,54 and 28,59, therefore, differ in scope, since at least one entity is identified in Claims 23 and 54, while at least two entities are identified in Claims 28 and 59. It follows, therefore, that the dependant claim sets 24-27 and 55-58, corresponding to independent Claims 23 and 54, respectively, and dependant claim sets 29-32 and 60-63, corresponding to independent Claims 28 and 59, respectively, also inherit these differences in scope.

Applicant respectfully submits, therefore, that Claims 24-27, 29-32, 55-58, and 60-63, set forth sufficient differences in scope to be allowable under MPEP § 706.03(k).

Applicant respectfully submits, therefore, that no correction is necessary and that the duplicate claims objection should be withdrawn.

The office action fails to establish that Claims 1-8, 11-25, 27-30, 32-33, 35-56, 58-61, 62-64, and 66-67 are anticipated under 35 U.S.C. 102(e) by U.S. Patent No. 6,917,594 to Feuerstraeter et al (hereinafter "Feuerstraeter"). However, Applicant has amended Claims 1, 15, 33, 37, 46, and 64 in order to advance prosecution of the instant application. In particular, Applicant's Claims 1, 15, 33, 37, 46, and 64 are amended to set forth at least that "the transmission convention is selected in response to the determined transmission characteristics of a transmission path between the transmitting entity and the target entity prior to the data transmission."

To anticipate a claim, the asserted reference must teach all the limitations of the claimed invention. Feuerstraeter, however, is not shown to teach the use of determined transmission characteristics of a transmission path between a transmitting entity and a target entity in order to select a transmission convention prior to data transmission. Instead, Feuerstraeter seems to teach that the transmission characteristics of the transmission path are ignored by the IEEE 802.3 standard, since in Section 28.1.4.3 of the IEEE 802.3-2002 standard, it is merely assumed that the transmission path, e.g., the cabling, conforms to the advertised capability during the auto-negotiation protocol.

Thus, the IEEE 802.3-2002 standard, as purportedly incorporated by reference in Feuerstraeter, seems to base the transmission convention on assumed, rather than determined, cabling capabilities. (See column 6, lines 11-41). Furthermore, Feuerstraeter seems to teach that only until after the data transmission has commenced are the transmission characteristics considered, i.e., only until after excessive data errors are detected in the transmitted data is the data rate reduced. (See column 6, lines 41-59; column 8, lines 42-49).

Applicant's claims 1, 15, 33, 37, 46, and 64, on the other hand, set forth at least that "the transmission convention is selected in response to the determined transmission characteristics of a transmission path between the transmitting entity and

the target entity prior to the data transmission." Thus, the transmission characteristics are first determined, then a transmission convention is selected in response to the determined transmission characteristics. The Applicant respectfully submits, therefore, that Claims 1, 15, 33, 37, 46, and 64 patentably distinguish over Feuerstraeter and are in condition for allowance.

Dependent Claims 2-8, 11-14, 16-22, 35-36, 38-45, 47-53, and 67, which are dependent from independent Claims 1, 15, 33, 37, 46, and 64, respectively, are also rejected under 35 U.S.C. §102(e) as being unpatentable over Feuerstraeter. While Applicant does not acquiesce to the particular rejections to these dependent claims, it is understood that these rejections are now moot in view of the amendments and remarks made in connection with independent Claims 1, 15, 33, 37, 46, and 64. These dependent claims include all of the limitations of the base claims and any intervening claims, and recite additional features which further distinguish these claims from the cited references. Therefore, dependent Claims 2-8, 11-14, 16-22, 35-36, 38-45, 47-53, and 67 are also in condition for allowance.

Claims 23, 28, 54, and 59, set forth an apparatus and a method for establishing a data transmission by defining at least that "determining [a] number of transmission resources [is] based on the bandwidth of the data transmission and a transmission convention." Furthermore, the data transmission continues by "accessing the number of transmission resources to transmit data to the target entity". Feuerstraeter, however, is not shown to determine a number of transmission resources to be used for a data transmission based upon a bandwidth of the data transmission. Rather, Feuerstraeter is shown to select between one of two bandwidths for use during the data transmission, e.g., 10 or 100 Mbps, and then regardless of the bandwidth used, a single resource, e.g., a single category 3 or category 5 cable, is used for the data transmission. (See column 6, lines 11-40, along with FIG. 1). Thus, the number of transmission resources selected by Feuerstraeter seems to be independent of the bandwidth used. Thus, Applicant respectfully submits that Claims 23, 28, 54, and 59 are in condition for allowance.

Dependent Claims 24-25, 29-30, 32, 55-56, 58, 60-61, and 62-63, which are dependent from independent Claims 23, 28, 54, and 59, respectively, are also

rejected under 35 U.S.C. §102(e) as being unpatentable over Feuerstraeter. While Applicant does not acquiesce to the particular rejections to these dependent claims, it is understood that these rejections are now moot in view of the remarks made in connection with independent Claims 23, 28, 54, and 59. These dependent claims include all of the limitations of the base claims and any intervening claims, and recite additional features which further distinguish these claims from the cited references. Therefore, dependent Claims 24-25, 29-30, 32, 55-56, 58, 60-61, and 62-63 are also in condition for allowance.

Furthermore, the Office Action has also identified certain claim language in Claims 1, 2-3, and 7-8 of Feuerstraeter, as teaching elements of Claims 5-8, 11, 15-21, 23-25, 28-30, 32-33, 35-37, 39-42, 47-52, 54-55, 58, 60, 63, and 66-67 of the instant application. It is respectfully submitted that the claim language of Feuerstraeter as cited by the Office Action is not sufficiently clear to consider as to the alleged specific teaching.

The office action fails to establish that Claim 37 is anticipated under 35 U.S.C. 102(e) by U.S. Patent No. 6,266,701 to Sridhar et al (hereinafter "Sridhar"). However, Applicant has amended Claim 37, as discussed above, in order to advance prosecution of the instant application.

To anticipate a claim, the asserted reference must teach all the limitations of the claimed invention. Similar to Feuerstraeter, Sridhar is not shown to teach the use of determined transmission characteristics of a transmission path between a transmitting entity and a target entity in order to select a transmission convention prior to data transmission. Instead, Sridhar seems to teach that the transmission path, i.e., physical layer, is unknown to the transmitting entity, i.e., proxy application 613. In particular, Sridhar seems to teach that proxy application 613 is unaware that a communication path can be established at the point of making the request, nor is proxy application 613 aware as to whether the TCP or XTP protocol is to be used. (See column 16, lines 5-14). Furthermore, Sridhar seems to teach that proxy application 613 is unaware as to the path that will be taken to transmit the data, i.e., whether the data is to be sent to server computer 618, remote communication server 626, or handled by the gateway computer. (See column 16, lines 25-31). As such,

Sridhar seems to be unable to ascertain transmission characteristics of a transmission path, since the path is unknown. Accordingly, Applicant submits that Claim 37 patentably distinguishes over Sridhar and is in condition for allowance.

Furthermore, the Office Action has also identified certain claim language in Claims 1, 5, and 11 of Sridhar, as teaching elements of Claim 37. It is respectfully submitted that the claim language of Sridhar as cited by the Office Action is not sufficiently clear to consider as to the alleged specific teaching.

The office action fails to establish that Claims 9-10, 26, 31, 57, and 62 are unpatentable over Feuerstraeter in view of Computer Networks by Andrew S. Tanenbaum (hereinafter "Tanenbaum") under 35 U.S.C. 103(a).

To establish *prima facie* obviousness of a claimed invention, the Examiner has the burden of proving that three basic criteria are met. First, there must be some suggestion or motivation to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicants' disclosure. All three of these criteria must be met in order to support a finding of *prima facie* obviousness of a claimed invention (See MPEP § 2142).

Concerning the third criteria which must be met to establish *prima facie* obviousness of a claimed invention, and as discussed above, Feuerstraeter has not been shown to teach or suggest the use of determined transmission characteristics of a transmission path between a transmitting entity and a target entity in order to select a transmission convention prior to data transmission, as is at least set forth in independent Claim 1. Furthermore, Feuerstraeter is not shown to determine a number of transmission resources to be used for a data transmission based upon a bandwidth of the data transmission, as is at least set forth in independent Claims 23, 28, 54, and 59.

On page 21, the Office Action tacitly acknowledges that Feuerstraeter fails to teach or suggest all of the claim limitations recited in Applicant's dependent Claims 9-10, 26, 31, 57, and 62. Since Claims 9-10, 26, 31, 57, and 62 also depend upon

independent Claims 1, 23, 28, 54, and 59, respectively, however, then Feuerstraeter is also deficient with respect to the limitations set forth in independent Claims 1, 23, 28, 54, and 59 as discussed above. Applicant respectfully asserts that these deficiencies do not constitute facts outside of the record which are capable of instant and unquestionable demonstration as being "well-known" in the art. Applicant also requests the specific pages in the text book by Tanenbaum used for evidence of official notice by the Examiner.

In determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. Taking official notice of the above-discussed facts disregards the requirement of analyzing Applicants' claimed subject matter as a whole. Applicants respectfully reiterate the legal tenet that facts so noticed should not comprise the principle evidence upon which a rejection is based. MPEP § 2144.03. Thus, since Tanenbaum has not been shown to remedy the deficiencies of Feuerstraeter with regard to each element of the rejected dependent claim and each element of the corresponding independent claim, the rejection of Claims 9-10, 26, 31, 57, and 62 fails as to the third criteria, which must be met to support a finding of *prima facie* obviousness.

Concerning the first criteria discussed above, which must be met to support a finding of *prima facie* obviousness, the Office Action provides no reason to combine the teachings of Feuerstraeter with Tanenbaum other than to state that Tanenbaum teaches "a well known process in the art". The fact the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness. MPEP § 2143.01. Thus, the rejection of Claims 9-10, 26, 31, 57, and 62 fails as to the first criteria, which must be met to support a finding of *prima facie* obviousness. Applicant respectfully submits, therefore; that Claims 9-10, 26, 31, 57, and 62 patentably distinguish over the combination of Feuerstraeter and Tanenbaum and are in condition for allowance.

The office action fails to establish that Claims 34 and 65 are unpatentable over Feuerstraeter in view of U.S. Patent No. 6,618,360 to Scoville et al (hereinafter

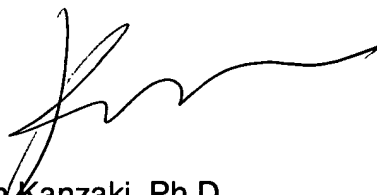
"Scoville") under 35 U.S.C. 103(a). However, Applicant has amended Claims 33 and 64, as discussed above, in order to advance prosecution of the instant application.

Concerning the third criteria which must be met to establish *prima facie* obviousness of a claimed invention, and as discussed above, Feuerstraeter has not been shown to teach or suggest the use of determined transmission characteristics of a transmission path between a transmitting entity and a target entity in order to select a transmission convention prior to data transmission, as is at least set forth in independent Claims 33 and 64. The combination of Feuerstraeter with Scoville, however, fails to remedy this deficiency and thus fails to establish *prima facie* obviousness with respect to Claims 33 and 64. Furthermore, since Claims 34 and 65 include all of the limitations of Claims 33 and 64, respectively, and recite additional features which further distinguish these claims from the combination of Feuerstraeter with Scoville, Applicant respectfully submits that Claims 34 and 65 patentably distinguish over the combination of Feuerstraeter with Scoville and are in condition for allowance.

CONCLUSION

Reconsideration and a notice of allowance are respectfully requested in view of the Amendments and Remarks presented above. If the Examiner has any questions or concerns, a telephone call to the undersigned is invited.

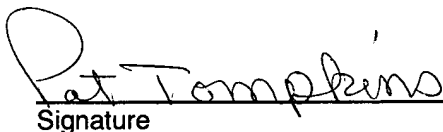
Respectfully submitted,



Kim Kanzaki, Ph.D.
Attorney for Applicants
Reg. No.: 37,652
(408) 879-6149

I hereby certify that this correspondence is being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on December 2, 2005.

Pat Tompkins
Name


Signature